

REMARKS

This is a full and timely response to the non-final Office Action of March 23, 2006.

Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this First Response, claims 17-20 and 22-34 are pending in this application. Claims 17-20, 23, and 24 are directly amended herein, and claims 1-16 and 21 are canceled without prejudice or disclaimer. In addition, claims 25-34 are newly added. It is believed that the foregoing amendments add no new matter to the present application.

Election/Restriction

The outstanding Office Action indicates that restriction is required to one of the following alleged invention: Invention I (claims 1-16) and Invention II (claims 17-24). Applicant elects Invention II (claims 17-24) without traverse. Non-elected claims 1-16 have been canceled via the amendments set forth herein.

Specification Objection

The disclosure is objected to as containing an alleged informality. Applicant submits that the specifications has been amended herein to correct the alleged informality. Accordingly, Applicant requests that the objection to the specification be withdrawn.

Response to §112 Rejections

Claims 17-19 and 23 presently stand rejected under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 17-19 and 23 have been amended herein mooting the rejections of these claims under 35 U.S.C. §112, second paragraph. Therefore, Applicant respectfully requests that the rejections of claims 17-19 and 23 under 35 U.S.C. §112, second paragraph be withdrawn.

Response to §102 and §103 Rejections

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Furthermore, in order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted).

Claim 17

Claim 17 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Chang* (U.S. Patent No. 6,365,500) or *Karnezos* (EP 0 295 914). Claim 17 also presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Nolan* (U.S. Patent No. 5,508,228).

Claim 17, as amended, reads as follows:

17. A device, comprising:
a first substrate;
a second substrate; and
a compliant element of a first, compliant material between said first substrate and said second substrate, said compliant element comprising a side surface coated at least in part with a layer of a second material, said compliant element exhibiting deformation consistent with said first substrate and a second side having been pressed together, ***wherein said layer of said second material provides said compliant element with a greater hermeticity than said first material alone and wherein said compliant element provides a hermetic seal for a chamber within said device.*** (Emphasis added).

Applicant respectfully asserts that the cited art fails to disclose at least the features of claim 17 highlighted hereinabove. Therefore, the 35 U.S.C. §102 rejection of claim 17 is improper.

In this regard, the cited art generally shows various electrical connections formed between substrates, and it is alleged in the Office Action that such electrical connections constitute the “compliant element” recited by claim 17. However, none of the disclosed electrical connections appears to provide “a hermetic seal for a chamber.” Accordingly, Applicant respectfully asserts that the cited art fails to disclose a “compliant element comprising a side surface coated at least in part with a layer of a second material... (that) provides said compliant element with a greater hermeticity than said first material alone and ***wherein said compliant element provides a hermetic seal for a chamber within said device,***” as recited by claim 17. (Emphasis added).

For at least the above reasons, Applicant respectfully asserts that the cited art fails to disclose each feature of claim 17, as amended. Accordingly, the 35 U.S.C. §102 rejection of claim 17 should be withdrawn.

Claims 18-20, 22, 28, and 29

Claims 18-20 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Chang*, *Karnezos*, or *Nolan*. Further, claim 22 presently stands rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Chang* or *Karnezos* or *Nolan* in view of *Neidich* (U.S. Patent No. 6,358,063). In addition, claims 28 and 29 have been newly added via the amendments set forth herein. Applicant submits that the pending dependent claims 18-20, 22, 28, and 29 contain all features of their respective independent claim 17. Since claim 17 should be allowed, as argued hereinabove, pending dependent claims 18-20, 22, 28, and 29 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 23

Claim 23 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Chang* or *Karnezos* or *Nolan* in view of *Neidich*. Claim 23, as amended, reads as follows:

23. A device, comprising:
a first substrate;
a second substrate; and
a compliant gasket between said first substrate and said second substrate,
said compliant gasket coated with a hermeticity-increasing layer and exhibiting
deformation consistent with said first substrate and said second substrate having
been pressed together. (Emphasis added).

Applicant respectfully asserts that the cited art fails to suggest at least the features of claim 23 highlighted hereinabove. Therefore, the 35 U.S.C. §103 rejection of claim 23 is improper.

In this regard, it is candidly admitted in the Office Action that *Chang, Karnezos, and Nolan* “do not teach having a gasket around the conductive bumps.” It is, nevertheless, asserted in the Office Action that:

“Neidich teaches an interposer assembly comprised of an interposer (or connector) and a gasket, wherein the assembly is placed between two circuit members (col 1 L 63-67).

(the) gasket (24) is a resilient material which surrounds the entire outer periphery of the interposer (16) (col 2 L 59-65, Figs. 2 & 8).

In view of the prior art teachings, one skill in the art would include a gasket of any desired material in a face-to-face circuit bonding assembly because the gasket serves as an edge sealant as well as prevents contaminants.”

Neidich indeed shows a gasket. However, such a gasket is not “coated with a hermeticity-increasing layer,” as recited by claim 23. Further, none of the references of the cited art provides any suggestion or motivation for coating the gasket of *Neidich* with a “hermeticity-increasing layer.” Accordingly, Applicant submits that the cited art fails to suggest a “compliant gasket coated with a hermeticity-increasing layer,” as recited by claim 23.

In addition, to establish a proper rejection under 35 U.S.C. §103 based on a combination of references, it is incumbent on the Patent Office to establish that the *cited art* provides a motivation for combining the references. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hospital Systems, Inc., v. Montefiore Hospital*, 732 F.2d 1571, 1572, 1577; 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Applicant respectfully submits that the Office Action fails to establish that the cited art provides any reason or motivation for combining

Neidich with *Chang* or *Karnezos* or *Nolan*. Therefore, the alleged combinations are improper.

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

For at least the above reasons, Applicant respectfully asserts that the cited art fails to suggest each feature of pending claim 23 and that the alleged combinations of *Neidich* with *Chang* or *Karnezos* or *Nolan* are improper. Therefore, the 35 U.S.C. §103 rejection of claim 23 should be withdrawn.

Claims 24-27

Claim 24 presently stands rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Chang* or *Karnezos* or *Nolan* in view of *Neidich*. In addition, claims 25-27 have been newly added via the amendments set forth herein. Applicant submits that the pending dependent claims 24-27 contain all features of their respective independent claim 23. Since claim 23 should be allowed, as argued hereinabove, pending dependent claims 24-27 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 30

Claim 30 has been newly added via the amendments set forth herein. Claim 30 presently reads as follows:

30. A device, comprising:
a first substrate;
a second substrate; and
a compliant gasket between said first and second substrates, said compliant gasket exhibiting deformation consistent with said first and second substrates having been pressed together, said compliant gasket having a surface coated at least in part with a hermeticity-increasing layer such that said compliant gasket provides a hermetic seal for a chamber between said first and second substrates.

Applicant respectfully asserts that the cited art fails to disclose or suggest each of the features of claim 30 set forth above. Accordingly, claim 30 is allowable.

Claims 31-34

Claims 31-34 have been newly added via the amendments set forth herein. Applicant submits that the pending dependent claims 31-34 contain all features of their respective independent claim 30. Since claim 30 should be allowed, as argued hereinabove, pending dependent claims 31-34 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

By: _____

Jon E. Holland
Reg. No. 41,077

100 Galleria Parkway, N.W.
Suite 1750
Atlanta, Georgia 30339
(256) 704-3900 Ext. 103